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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/747,122    11/08/96    SELAWRY

H    8661-009

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HM22/0610

EXAMINER

DELACROIX MUIRHEI, C

ART UNIT

PAPER NUMBER

1654

*13*

DATE MAILED:

06/10/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/747,122

Applicant(s)

SELAWRY et al

Examiner

C. DELACROIX-M.

Group Art Unit

1654

☒ Responsive to communication(s) filed on 3/15/1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-52 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-52 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Applicant: SELAWRY et al.

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#### DETAILED ACTION

The following is responsive to Applicant's amendment received Mar. 15, 1999.

No claims are cancelled. New claims 50-52 are added. Claims 1-52 are currently pending.

#### *Specification*

Applicant's abstract has been received and entered into the application.

#### *Request for Interference*

Applicant's request for interference is noted. However, the inventive entity between the instant application and that of '854, '534, '430 and '285 is common by at least one inventor, Selawry, and, as stated in the previous action mailed Dec. 22, 1998, there is no common assignee listed in the instant application. Additionally, claim 50 is rejected for reasons that are given hereinbelow. An interference will not be initiated until notification of the assignee of the instant application and allowability of all claims is indicated.

#### *Double Patenting*

1. Claims 34-40 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 34-40 of prior U.S. Patent No. 5,725,854. This is a double patenting rejection. Said rejection, which was set forth in paragraph 2 of the office action mailed Dec. 22, 1998, is maintained.
2. Claims 41-46 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of prior U.S. Patent No. 5,759,534. This is a double patenting rejection. Said rejection, which was set forth in paragraph 3 of the office action mailed Dec. 22, 1998, is maintained.
3. The previous double patenting rejection of claims 1-33, set forth in paragraphs 4 and 5 of the office action mailed April 1, 1998, **is maintained.**

4. Claims 47-49 are rejected under the judicially created doctrine of double patenting over claims 1-6 of U. S. Patent No. 5,759,534 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Said rejection, which was set forth in paragraphs 5 and 6 of the office action mailed Dec. 22, 1998 is maintained.

***New Ground of Rejection***

***Claim Rejections - 35 USC § 112***

5. Claim 50 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim recites a method for treating an "autoimmune disease" in a mammal. Yet, there is no support, implicit or explicit, in Applicant's specification for said method. Applicant refers to page 17, lines 15-19 for support, stating that the specification provides support by describing treatment of Type I diabetes. The Examiner respectfully disagrees. It is the Examiner's position that the specific treatment of Type I diabetes would not reasonably convey to one skilled in the relevant art that the inventors had possession of a method aimed at treating the broadly claimed condition of an "autoimmune disease". Claim 50 recites method limitations that are broader than what was originally disclosed at the time the application was filed. Accordingly, the claims introduce new matter.

***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claim 50 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S.

Patent No. 5,849,285. This is a double patenting rejection.

8. Claims 47, 48 and 51-52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims

1, 2 of prior U.S. Patent No. 5,843,430. This is a double patenting rejection.

### **Conclusion**

Hence, claims 1-52 are rejected.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on (703) 308-0254. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

CDM

June 6, 1999

  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600